

**REMARKS/ARGUMENTS**

Claims 2-9, 15-19 and 21 were pending in the application when the present Office Action was mailed. No claims have been amended, added, or cancelled by this response. Accordingly, claims 2-9, 15-19, and 21 remain pending.

In the Office Action, claims 2-9 and 15-19 were rejected, and claim 21 was allowed. More specifically, the status of the claims in light of the Office Action is as follows:

(A) Claims 2, 3, 5-9, 15, 16, 18 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over European Patent Application No. 0,351,217 to Goh ("EPO '217") in view of U.S. Patent No. 5,970,875 to Hoffmann et al. ("Hoffmann");

(B) Claims 4 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over EPO '217 in view of Hoffmann and further in view of U.S. Patent No. 5,466,012 to Puckett et al. ("Puckett"); and

(C) Claim 21 was indicated to be allowable.

The undersigned attorney wishes to thank the Examiner for engaging in a telephone interview on December 11, 2003 to discuss the present Office Action. The following remarks reflect and expand on the agreements reached between the undersigned attorney and the Examiner during the December 11 telephone interview. For example, the following remarks reflect the Examiner's acknowledgement that EPO '217 and Hoffmann cannot support a Section 103 rejection of independent claim 2 for at least the reason that these references, either alone or in combination, fail to teach or suggest all of the claim features. One feature these references fail to teach or suggest is placing visible marks on a substrate with a marking medium that has a first appearance on the substrate but a second, different appearance when photocopied. Because these references cannot support a Section 103 rejection of claim 2, the Examiner further agreed to remove the finality of the present Office Action.

Information Disclosure Statements (IDSs) were filed in this application on November 22, 2002, December 16, 2002, April 25, 2003, and December 1, 2003. The record does not include any acknowledgement by the Examiner that he has reviewed any of the references included with these IDSs. Accordingly, the undersigned respectfully requests that the Examiner review the references included in each of the IDSs and acknowledge his review in the record.

A. Response to the Section 103 Rejection of Claims 2, 3, 5-9, 15, 16, 18 and 19

Claims 2, 3, 5-9, 15, 16, 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over EPO '217 in view of Hoffmann.

1. Independent Claim 2 is Directed to a Method for Providing a Voucher That Includes, *Inter Alia*, Placing Marks on a Substrate With a Marking Medium That has a First Appearance on the Substrate but a Second Appearance in a Photocopy of the Substrate

Independent claim 2 is directed to a method for providing a voucher in a coin discriminator having a discriminator printer. The voucher is configured to assist in distinguishing unauthorized duplicate or counterfeit vouchers. The method includes, *inter alia*, placing visible marks on a first substrate with a marking medium. The visible marks have a first appearance on the substrate, but a photocopy of the visible marks has a second appearance that is different than the first appearance. The method further includes using the discriminator printer to print at least first indicia on the substrate. The first indicia contains an indication of a value of the voucher.

2. EPO '217 is Directed to an Apparatus for Determining the Value of a Batch of Mixed Coins

As shown in Figure 2 of EPO '217, EPO '217 is directed to an apparatus for determining the value of a batch of coins, and includes a hopper unit 1 in which there is a rotatable disk 2. The rotatable disk 2 feeds coins from the hopper unit 1 in single file past a coin discriminator 6 to an escrow region 11. By selecting an appropriate actuator, a user may elect to receive a receipt for the coins inserted into the hopper unit 1.

3. Hoffmann is Directed to a Document Substrate Having a First Surface Configured to Receive a First Visual Image by Transfer From an Ink Ribbon, and a Second Surface Configured to Receive a Second Visual Image by Activation of a Pressure-Sensitive Chromogenic Coating

As shown in Figure 1 and explained in columns 4 and 5 of Hoffmann, Hoffmann teaches a document substrate 12 that is coated on an underside 18 with a pressure-sensitive chromogenic coating 14. The substrate 12 can be a paper web having a topside 16 that is not coated with the pressure-sensitive chromogenic coating 14. (Hoffmann col. 5; lines 40-45.) The substrate 12 is configured to simultaneously receive visible images on both the topside 16 and the underside 18. As Hoffmann explains, an impact printer 114 having an inked ribbon 116 provides a principal image on the topside 16 of the substrate 12. The impact pressure of the stylus of the impact printer 114 simultaneously ruptures the pressure-sensitive chromogenic coating 14 on the underside 18 of the substrate 12, so that the coating 14 forms the mirror image of the principal image on the underside 18 of the substrate 12. (Col. 7 of Hoffmann, lines 27-49.)

4. EPO '217 and Hoffmann Cannot Support a Section 103 Rejection of Independent Claim 2 for at Least the Reason That These References Fail to Teach or Suggest a Marking Medium That has a First Appearance on a Substrate but a Second Appearance in a Photocopy of the Substrate

The method of independent claim 2 includes placing visible marks on a substrate with a marking medium that has a first appearance on the substrate but a second, different appearance in a photocopy of the substrate. As the Office Action correctly states, EPO '217 fails to teach the use of such a marking medium. Further, all Hoffmann teaches is a method for simultaneously creating marks on both sides of a substrate. Accordingly, as the Examiner acknowledged during the December 11 telephone interview, EPO '217 and Hoffmann cannot support a Section 103 rejection of independent claim 2, and the rejection should be withdrawn.

Claims 3-5 depend from base claim 2. Accordingly, the applied references of EPO '217 and Hoffmann cannot support a Section 103 rejection of dependent claims 3-

5 for at least the reasons discussed above with regard to the rejection of base claim 2, and for the additional features of these dependent claims. For example, dependent claim 5 recites that the marking medium of claim 2 includes fluorescent ink. Neither of the applied references teach or suggest the use of fluorescent ink. To overcome this deficiency, the Office Action simply asserts that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to use fluorescent ink, since it has been held to be within the general skill level of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 U.S.P.Q. 416." (Emphasis added.) Applicants respectfully disagree with this conclusory assertion. In *Leshin*, selection of a known plastic to make a container of a type made of plastics was held to be obvious. (MPEP 2144.07.) In the present case, however, neither of the applied references have identified an "intended use" for which florescent ink is a known suitable alternative. That is, neither of the applied references has identified an intended use for an ink that looks different in photocopies than it did when originally applied to a substrate. The reason for this is that neither of the applied references are even remotely concerned with this aspect of voucher production. Absent any clear teaching of an intended use for fluorescent ink, it is inappropriate to assert that it would have been obvious to one of ordinary skill in the art to use such ink based on the teachings of Hoffman or EPO '217.

The MPEP clearly states, to establish a *prima facie* case of obviousness, the applied references must teach or suggest all of the claimed features. Neither EPO '217 nor Hoffman teach or suggest fluorescent ink. Therefore, the Section 103 rejection of dependent claim 5 should be withdrawn for at least this additional reason.

Claim 6 is directed to a method for providing a voucher in a coin discriminator having a discriminator printer. The method includes placing visible marks on a substrate using a fluorescent marking medium. For the reasons discussed above with regard to the rejection of claim 5, neither of the applied references of EPO '217 or Hoffmann teach or suggest the use of a fluorescent marking medium. Therefore, the rejection of claim 6 should be withdrawn.

5. Independent Claim 7 is Directed to a Method for Providing a Voucher in a Coin Discriminator That Includes, *Inter Alia*, Placing Visible Marks on a Substrate Positioned Less Than 0.25 Inch From an Edge of the Substrate

The method of claim 7 includes placing visible marks less than 0.25 inch from an edge of a substrate. Neither of the applied references of EPO '217 or Hoffmann teach or suggest such mark placement. Although the Office Action is somewhat vague as to the actual basis for the rejection of claim 7, it appears that the Office Action is attempting to establish a proper Section 103 rejection by simply asserting that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the indicia in any desired location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70."

Applicants respectfully reject the supposition that the claimed mark placement is nothing more than "rearranging parts of an invention." As the specification of the present application clearly states, this mark placement can provide embodiments of the invention with advantages over other approaches:

[I]t is preferred that some or all anti-counterfeiting features described herein can be provided as pre-printing or pre-providing (i.e. can be provided on the paper stock or paper supply 226 before it is fed to the printer 18). This is particularly useful in connection with providing the edge printing 316 relatively close to the edges 318a, b since close-to-edge printing is a feature which is difficult to reproduce with many inkjet, laser, or other computer based printers (which often require a minimum space, such as a space no less than about 0.25 inch, between the paper edge and printing provided by such printer).

(Present Application No. 09/960,599; pg. 11, ll. 14-20.)

Neither EPO '217 nor Hoffman make any mention of voucher printing that is within 0.25 inch of an edge of a substrate. Absent any such teaching, it is inappropriate to assert that it would have been obvious to one of ordinary skill in the art to locate the indicia taught by EPO '217 or Hoffmann within 0.25 inch of the edge of a substrate, especially in light of the present application which teaches that such "close-to-edge printing is a feature which is difficult to reproduce with many inkjet, laser, or other

computer based printers.” Therefore, EPO '217 and Hoffmann cannot support a Section 103 rejection of claim 7, and the rejection should be withdrawn.

6. Independent Claim 8 Is Directed to a Method for Providing a Voucher in a Coin Discriminator That Includes, *Inter Alia*, Printing a First Language on a Substrate Oriented in a First Direction, and Printing a Second Language on the Substrate Oriented in a Second Direction at an Angle to the First Direction

The method of independent claim 8 includes printing a first language on a substrate in a first direction, and printing a second language on the substrate in a second direction that is at an angle relative to the first direction. Neither of the applied references of EPO '217 or Hoffmann teach or suggest such first or second languages in such orientations. The Office Action appears to acknowledge this conclusion, because it fails to identify where these claimed features are taught by the applied references. Instead, the Office Action simply asserts that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the indicia in any desired location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.”

The MPEP requires that the Examiner properly communicate the basis for a rejection so that the issues can be identified early and the applicants can be given fair opportunity to respond. (MPEP 706.02(j).) In the present case, applicants respectfully submit that the cursory assertion provided above does not suffice to properly communicate the basis for the rejection of the claim 8. As a result, applicants have not been given a fair opportunity to consider and respond to a properly framed *prima facie* rejection. For at least this reason, the rejection of claim 8 should be withdrawn.

Further, according to the MPEP, the applied references of EPO '217 and Hoffmann must teach or suggest first language and second language printed on a substrate at an angle relative to each other. Nowhere has the Office Action identified where the applied references teach or suggest such angled languages. Accordingly, the rejection of claim 8 should be withdrawn for this additional reason.

In addition, the MPEP clearly states that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (MPEP 2143.01; emphasis added.) In the Office Action, the Examiner has not cited a single prior art reference that suggests the desirability of the claimed arrangement of the first and second languages. Accordingly, applicants respectfully request that the Examiner cite a reference in support of his assertion that the claimed arrangement of the first and second languages of claim 8 would have been obvious to one having ordinary skill in the art. Absent such a cite, the rejection of claim 8 should be withdrawn.

Claim 9 depends from base claim 8. Accordingly, the applied references cannot support a Section 103 rejection of claim 9 for at least the reasons discussed above with regard to the rejection of claim 8, and for the additional features of claim 9. Therefore, the rejection of claim 9 should be withdrawn.

Claim 15 is directed to a method for providing a voucher that includes, *inter alia*, placing a series of identifier symbols on a first substrate, said series of identifier symbols being spaced from one another. EPO '217 and Hoffmann fail to teach or suggest such spaced apart identifier symbols. Accordingly, these applied references cannot support a Section 103 rejection of claim 15, and the rejection should be withdrawn. Furthermore, the Office Action fails to identify *where* the applied references teach the claimed subject matter. In this regard, applicants respectfully submit that the Examiner has not communicated a properly framed *prima facie* rejection of claim 15. As a result, applicants have not been given a fair opportunity to consider and respond to a properly framed *prima facie* rejection. For at least this additional reason, the rejection of claim 15 should be withdrawn.

Claims 16, 18 and 19 depend from base claim 15. Accordingly, the applied references cannot support a Section 103 rejection of dependent claims 16, 18 and 19 for at least the reasons discussed above with regard to the rejection of base claim 15, and for the additional features of these dependent claims. Therefore, the rejection of dependent claims 16, 18 and 19 should be withdrawn.

B. Response to the Section 103 Rejection of Claims 4 and 17

Dependent claims 4 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over EPO '217 in view of Hoffmann and further in view of Puckett. Claim 4 depends from base claim 2, and claim 17 depends from base claim 15. As discussed in detail above, EPO '217 and Hoffmann cannot support a Section 103 rejection of base claims 2 and 15. Further, Puckett does not cure the deficiencies of EPO '217 and Hoffmann in regard to the rejection of base claims 2 and 15. In fact, the Office Action only relies on Puckett to provide the thermal paper substrate recited in claim 4. Therefore, EPO '217, Hoffmann, and Puckett cannot support a Section 103 rejection of dependent claims 4 and 17 for at least the reason that these applied references cannot support a Section 103 rejection of corresponding base claims 2 and 15. Therefore, the rejection of claims 4 and 17 should be withdrawn.

The rejection of claim 4 should be withdrawn for an additional reason. Claim 4 is directed to the method of claim 2, and further recites that the substrate is thermal paper. To provide this feature, the Office Action points to Puckett, which mentions thermal paper in connection with a facsimile security system. However, as the MPEP clearly states, "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claims invention were individually known in the art, is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." (MPEP 2143.01; emphasis added.) In the Office Action, the Examiner asserts that it would have been obvious to modify Hoffmann with thermal paper as taught by Puckett to increase "the versatility of the printing process." This unsupported assertion, however, is insufficient to establish a *prima facie* case of obviousness because "the prior art must also suggest the desirability of the combination." (*Id.*; emphasis added.) In the present case, the Examiner has provided absolutely no indication of *where* the prior art suggests the desirability of modifying Hoffmann to include the thermal paper taught by Puckett. Absent the suggestion of the prior art, "the mere fact that references can be combined or modified does not render the resultant



combination obvious." *Id.* Therefore, EPO '217, Hoffmann and Puckett cannot support a Section 103 rejection of dependent claim 4 for this additional reason, and the rejection should be withdrawn.

C. Response to the Indication that Claim 21 is Allowable

Applicants thank the Examiner for indicating that claim 21 is allowable.

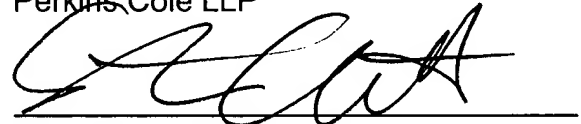
**CONCLUSION**

In view of the foregoing, a Notice of Allowance is respectfully requested. If the Examiner has any questions or believes another telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 264-6351.

No fees are believed due with this communication, however, the Commissioner is hereby authorized and requested to charge any deficiency in fees herein to Deposit Account No. 50-0665.

Respectfully submitted,

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